

REMARKS

Claims 6-9 and 22-26 have been withdrawn due to a restriction requirement. Claims 1-5 and 10-21 have been examined.

Claims 1-5 and 10-21 are rejected as anticipated by Guimil et al. (WO 03/004510), hereinafter “Guimil I,” under 35 U.S.C. § 102(a) and Guimil et al., (US 2004/0197851), hereinafter “Grimil II,” under 35 U.S.C. § 102(e). Guimil I is assigned a date of January 16, 2003 for purposes of prior art and is cited under § 102(a). Applicants enclose here a copy of a translation of PCT application WO 2004/058391, which is identical to the German-language priority application DE 102 60 591.2. This application therefore serves as an English translation of the priority document. A statement that the translation is accurate also is attached. Applicant therefore submits that the present application is entitled to the priority date of December 23, 2002, removing Guimil I as prior art. Applicant requests withdrawal of this rejection.

Guimil II, which has issued as U.S. Patent No. 7,355,036, is cited under 35 U.S.C. § 102(e). The published application document has been assigned, in the Action, an effective filing date of August 24, 2001 based on the U.S. provisional filing. Under 35 U.S.C. § 102(e), the PCT filing date of a U.S. application or patent is considered the U.S. filing date only if the international application on which it was based was filed on or after November 29, 2000, designated the U.S., and was PCT published in the English language. The international parent of Guimil II was PCT published January 16, 2003 in the German language. The U.S. national phase application of Guimil II was not filed until July 3, 2002 and was not perfected until January 9, 2004.

According to M.P.E.P. § 2136.03(II), international applications that do not meet the three criteria necessary for entitlement to international filing date recognition in the U.S. may not be used to reach back to an earlier date through a priority benefit claim for purposes of 35 U.S.C. § 102(e). The effective date of the U.S. Publication and the issued patent for purposes of prior art under section 102(e) is January 5, 2004, the date the application was perfected in the U.S. This date is not prior to the effective filing date of the present application, December 23, 2002. Moreover, the application was published January 16, 2003 and therefore also cannot be considered prior art against the present application under section 102(a). Applicant requests withdrawal of this rejection.

The Office has asserted that Guimil II serves as an English translation of Guimil I. Applicant submits that this is not relevant to the prior art status of either application. The earliest date any of the Guimil documents can be entitled to for purposes of prior art is January 16, 2003, under 35 U.S.C. § 102(a). Applicant submits that neither reference was published prior to the effective filing date of the present application and that neither reference qualifies as prior art here. Applicant therefore requests withdrawal of all rejections based on Guimil I or Guimil II.

Claim 2 is rejected as indefinite under 35 U.S.C. § 112, second paragraph, for recitation of the term “e.g.” Applicant has amended claim 2 herein to avoid this term and to avoid the term “or/and,” using more standard Markush language. New claim 27 is added to claim the subject matter deleted from claim 2. No new matter is added. Applicant requests withdrawal of this rejection.

Claims 1-5 and 10-20 are rejected on grounds of non-statutory double patenting over claims 1-9, 13 and 17-22 of U.S. Patent No. 7,355,036, hereinafter “Guimil III.” Guimil III independent process claims 1 and 13 refer to a method for the synthesis of nucleic acids, wherein the building block comprises two-stage protective groups containing a photoactivatable group selected from the specific groups NVOC, MeNPOC, DMBOC, NPPOC, o-nitrobenzyl and 2-(o-nitrophenyl)ethyl. In contrast, the photoactivatable groups, as indicated in present claim 1, are triplet-sensitized photoactivatable groups, labeled photoactivatable groups or both triplet-sensitized and labeled photoactivatable groups. This can be exemplified by the specific two-state protective group of present claim 4, which is a derivatized trityl group, wherein substituent Y of Guimil III is one of the specific groups recited in claim 1, but without any recitation of triplet sensitization or labeling.

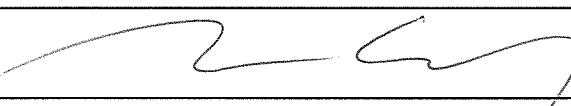
Dependent claims 3, 4 and others of Guimil III refer to fluorescent labels which may be located anywhere at the protective group. Claim 4 refers to a fluorescent group which is located at substituent Y, R₃ or/and Z. There is no limitation of the label to the photoactivatable group (i.e. Y in Guimil III), as in the present claims, in order to improve the molar extinction coefficient.

Page 2 of the present specification indicates that groups such as NVOC, MeNPOC or MPPOC have a comparatively low absorption coefficient at the wavelength of the incident light.

In contrast, triplet-sensitized photoactivatable groups and labeled triplet-sensitized photoactivatable groups have a high molar extinction coefficient. Further, they have an increased overall quantum yield in the activation step. A labeled photoactivatable group (without triplet-sensitization) shows merely a higher molar extinction coefficient (see specification, paragraph bridging pages 4 and 5). We therefore submit that the photoactivatable groups according to the present invention are advantageous compared to the groups recited in the claims of Guimil III.

For these reasons, Applicant submit that the claims of the present invention are distinct and nonobvious from those of the cited Guimil III patent. Applicant therefore requests withdrawal of the rejection made on grounds of double patenting.

Applicant requests reconsideration of the application and allowance of the claims as amended.

| | | | | | |
|-------------------------|---|-----------|--------------|----------|--------------|
| | Respectfully submitted, | | | | |
| NAME AND REG. NUMBER | Martha Cassidy, Ph.D. Reg. No. 44,066 | | | | |
| SIGNATURE |  | | | | |
| Address | Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800 | | | | |
| City | Washington | State | D.C. | Zip Code | 20005 |
| Country | U.S.A. | Telephone | 202-783-6040 | Fax | 202-783-6031 |

1561808